

27. (Previously Added) The method of Claim 16, further comprising replaying said advertisement script as a voice signal.

28. (Previously Added) The method of Claim 1, wherein the advertisement script includes wording of an advertisement and a date and time of when to broadcast the advertisement.

### REMARKS

By this amendment, claims 1-7, 14-17, 19-22, and 24-28 are pending, in which claim 2 is amended and claim 23 is canceled. No new matter is introduced.

The final Office Action mailed April 10, 2003 rejected claims 1, 4-5, 7, 13, 14 and 16-22 as obvious under 35 U.S.C. § 103(a) based on *Taubenheim et al.* (US 6,060,997) in view of *Fascenda et al.* (US 5,241,305), claim 2 as obvious under 35 U.S.C. § 103(a) based on *Taubenheim et al.* in view of *Fascenda et al.* and further in view of *Lewis et al.* (US 5,594,945), claims 3 and 6 as obvious under 35 U.S.C. § 103(a) based on *Taubenheim et al.* in view of *Fascenda et al.* and further in view of *DeLuca et al.*, claim 15 as obvious under 35 U.S.C. § 103(a) based on *Taubenheim et al.* in view of *Yeh et al.* (US 6,208,717), and claims 23-27 as obvious under 35 U.S.C. § 103(a) based on *Taubenheim et al.* in view of *Fascenda et al.* and further in view of *Dimitriades et al.* (US 5,664,948).

To reduce issues, Applicants have canceled independent claim 23. Independent claims 1, 5, 14, 16, 19, and 21 each recites “**generating a capcode associated with an advertisement script.**” Based on the terse response to Applicants’ arguments (page 5, items 6 and 7), it appears that the Office Action does not appreciate the distinction between the generalities suggested by the applied art with respect to use of capcodes and the specific recitation of the claimed invention. As Applicants have pointed out in the previous response,

many modern pagers may be programmed with more than one capcode each (as observed in *Fascenda et al.* col. 1:43-52), such that the claimed invention makes use of this feature to distribute an advertising script to one or more paging service subscribers having pagers programmed with the same capcode. Applicants note that the Office Action has taken the use of capcodes both in the *Taubenheim et al.* and *Fascenda et al.* systems entirely out of context and conveniently settles on an interpretation to satisfy the claims.

The Office Action, on page 2, acknowledges that *Taubenheim et al.* fails to teach the use of capcodes in the manner claimed, and thus, relies on *Fascenda et al.* for a supposed disclosure of capcodes, citing col. 1: 15-25. This cited passage states: "Each pager has an individual ID, called the capcode, stored in the pager. All the pagers in an area monitor broadcast messages from a central transmitter. Each message is intended for a particular pager and has that pager's capcode associated with the message. Thus, pagers in an area all monitor a certain frequency for broadcasts from the pager system transmitter looking for its capcode." This disclosure is merely the definition of a capcode, and falls short of suggesting "**generating a capcode associated with an advertisement script.**" The art of record provides no such disclosure of this claimed feature, even assuming the references of *Taubenheim et al.* and *Fascenda et al.* were properly combined based on some teaching or suggestion in the references, and assuming the modifications proposed in the Office Action were justified by additional teachings or suggestions found in the references.

Additionally, it is well established that under 35 U.S.C. §103, teachings of references can be combined only if there is some suggestion or incentive to do so. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Here, the prior art of record fails to provide any suggestion or incentive.

In fact, *Fascenda et al.* teaches away the proposed combination, by stating (col. 2: 38-44) that one drawback of the presently available pager systems is that they are not flexible. They are intended to provide the same message to one recipient or to a preset group of recipients only. Once the capcodes are set by the manufacturer or local paging company, they are not easily changed or removed from a pager. In addressing such a drawback, *Fascenda et al.*, for example, discloses that the pager preferably includes a unique electronic serial number (ESN) which is provided by the manufacturer in the memory of the pager. This is preferably a 64 bit number (two 32-bit code-words) and is used in addition to the capcode used as the pager ID supplied by the local pager company. This is used primarily for security control and accountability reasons. It also simplifies transmission of add/delete messages. This disclosure indicates the undesirability and limited functionality of using capcodes.

Despite the above teaching away, the Office Action suggests that the capcodes of the *Fascenda et al.* system can be used to achieve an operation that the *Taubenheim et al.* already achieves (i.e., via unique identification numbers) without the modification proposed by the Office Action. This rationale clearly undermines any motivation for combining the references, as the Office Action seeks to alter *Taubenheim et al.* to provide a redundant function. Applicants, therefore, respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations.

Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Therefore, Applicants contend that the present Office Action has failed to provide substantial evidence of motivation for modifying the admitted prior art based on the teachings of *Taubenheim et al.*, and *Fascenda et al.* as required by *In Re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000).

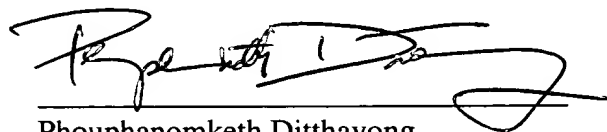
As regards the rejections of dependent claims 2, 3, 6, 15, and 24-27, the corresponding secondary references of *Lewis et al.*, *DeLuca et al.*, *Yeh et al.*, and *Dimitriades et al.* do not cure the deficiencies of *Taubenheim et al.* and *Fascenda et al.*, particularly with respect to the claimed feature of “**generating a capcode associated with an advertisement script.**” These secondary references were properly not applied to meet this feature.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-425-8516 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date



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**APPENDIX**

2. (Currently Amended) The method of Claim 1, further comprising:

storing the [generated identification number] capcode in a central database;

programming a paging unit of the paging service subscriber with the [identification number] capcode;

correlating the [identification number] capcode stored in the central database with [the identification number] a capcode programmed into the paging unit; and

transmitting the advertisement script and the message to the paging unit programmed with the [identification number] capcode based upon the correlation.

23. (Currently Canceled) [A method of messaging, comprising:

generating a capcode associated with at least one paging service subscriber;

attaching an advertisement script to a message for the paging service subscriber associated with the capcode; and

replaying said advertisement script as a voice signal.]